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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/555,575	06/01/2000	DANIEL DELORME	81823/268623	9220

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EXAMINER

DAVIS, BRIAN J

ART UNIT

PAPER NUMBER

1621

DATE MAILED: 01/02/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/555,575

Applicant(s)

DELORME ET AL.

Examiner

Brian J. Davis

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-5, 14, 16, 18 and 20-28 is/are pending in the application.
- 4a) Of the above claim(s) 20-22 and 25-28 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16 and 18 is/are allowed.
- 6) ☒ Claim(s) 4, 23 and 24 is/are rejected.
- 7) ☒ Claim(s) 3, 5 and 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

The examiner notes for the record that the lined-through references of the IDS (Paper No. 8) have not been considered as they are not physically present in the file. Indeed, the number for the British patent appears to be incorrect. If applicant wishes these references to be considered, the examiner respectfully suggests they be included with a supplemental IDS.

Election/Restrictions

Applicant's election (Paper No. 7), without traverse, of the claims of Group I for prosecution, and the elected species as compound 25, is acknowledged. It is also acknowledged that a preliminary amendment had not been taken into account when the original restriction requirement was formulated. The examiner regrets the error.

Accordingly, taking into account the preliminary amendment, the Groups should have been constituted as follows:

Group I: claims 3-5, 14, 16, 18, 23 and 24

Group II: claims 20-22 and 25

Group III: claims 26-28

As the preliminary amendment does not create a need to reformulate the original tripartite grouping of the claims – since the amendment simply cancels some claims outright and rewrites others as new claims – the restriction requirement is hereby made

FINAL. The subject matter of claims 20-22 and 25-28 is accordingly withdrawn from consideration as being drawn to non-elected subject matter.

Claim Objections

Claim 3 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n). Accordingly, the claim has not been further treated on the merits.

Claims 5 and 14 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits. The examiner notes for the record that once the objection to claim 3 has been overcome, the objection to claims 5 and 14 will be moot.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 23 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The exact compounds or substituents that applicant wishes to describe by the word 'prodrugs' is unclear.

Claims 23 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

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applicant regards as the invention. In the definition of R^2 (iii), 'q' is undefined.

Additionally, in the definition of R^2 (iv), it is unclear why a definition for 'q' is given when no variable 'q' appears in the substituent formula.

Allowable Subject Matter

The elected species and its obvious variants have been searched and are deemed free of the prior art. The obvious variants are defined when R^3 =halogen (in the elected species R^3 =Cl) and where all other variables are as defined in the elected species. The search was therefore expanded as called for under current Office Markush practice. With respect to claims 16 and 18, isotopically labeled compounds and compositions, this expanded search resulted in all remaining species being searched and deemed free of the prior art. With respect to claims 4, 23 and 24, one additional compound, beyond the elected species and its obvious variants, was searched. That compound is defined when $R^1=R^2=R^3=R^4=R^5$ =H and $n=m=1$. A rejection of follows.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 4, 23 and 24 are rejected, in so far as they read on the one additional compound defined above, under 35 U.S.C. 102(b) as being clearly anticipated by DE 19544687 (CAPLUS abstract). The reference teaches applicant's compound: RN=191868-11-8.

Conclusion

In view of the changes to the original claims, the examiner respectfully requests that a clean copy of all pending claims be included with applicant's response to this Office Action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Davis whose telephone number is 703-305-7129. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 703-308-4532. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1123.



Brian J. Davis
December 30, 2001